

REMARKS

Claims 1-10 and 19-21 are pending in this application. Claims 1, 20 and 21 have been amended to reword claim limitations. Applicants submit that the amendments and below remarks fully address all of the issues raised in the Final Office Action and request that the amendments be entered.

Content of the Specification

The Examiner states that Applicants should provide a list of applications by the same inventors, etc. and cite any references in an IDS that are pertinent to the instant application.

Applicants acknowledge their duties under 37 CFR 1.56 to disclose all information to be material to patentability. Applicants will review other applications and provide any information that is material to patentability for consideration by the Office in an IDS during the next available time to do so in prosecution.

Rejections under 35 U.S.C. § 103(a)

The rejections of pending claims are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,258,020 to Dai et al. in view of U.S. Patent No. 6,111,280 to Gardner and/or further in view one more additional references has been maintained.

Applicants maintain that the claim is patentable at least because “the polymer layer alters the electrical properties of the at least one nanotube from n-type to p-type response to application of a gate voltage.” Applicants have amended the claim to make clear that the limitation describes a specific material property of the polymer layer, namely that it alters the nanotube properties so that the resulting device exhibits properties of an n-type FET. This feature is not in the prior art.

In maintaining the rejection, the Examiner repeatedly states the following regarding various limitations (including the above) that were added to the claims in the last amendment:

“The recitation is not taken to be a positive limitation but only requires the ability to so perform. This recitation does not constitute a positive limitation in any patentable sense and therefore cannot be given patentable weight.” (Final Office)

Applicants disagree with that these limitations cannot be given patentable weight. Each of the limitations that the Examiner has refused to consider in light of the prior art references are either structural or functional limitations, which are positive limitations that must be considered. See, for example, the relevant MPEP section on functional limitations:

“A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step.” MPEP 2173.05(g)

Accordingly, Applicants request that the Examiner evaluate each of these limitations in light of the cited references and point to the source of the pertinent claim features in said references.

Conclusion:

In light of the foregoing amendments and remarks, Applicants respectfully submit that all pending claims are now in condition for allowance. Thus, Applicants respectfully request a Notice of Allowance from the Examiner. Should any unresolved issues remain, the Examiner is encouraged to contact the undersigned at the telephone number provided below. However, if the Commissioner determines that any additional fee is due, such fee may be charged to deposit account No. 504480 (Order No. NANOP002).

Respectfully submitted,
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